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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,834	12/24/2003	Hirokazu Sakai	247097US0	1125

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

NOTIFICATION DATE	DELIVERY MODE
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07/27/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,834	<b>Applicant(s)</b> SAKAI ET AL.	
	<b>Examiner</b> JYOTHSNA A. VENKAT Ph. D	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/8/04, 5/21/04, 11/3/04, 1/31/06 and 3/9/06</u> | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Receipt is acknowledged of election filed on 5/2/07 and IDS filed on 3/8/04, 5/21/04, 11/3/04, 1/3/06 and 3/9/06. Claims 1-10 are pending in the application and the status of the application is as follows:

#### ***Election/Restrictions***

Applicant's election with traverse of group I in the reply filed on 5/2/07 is acknowledged. The traversal is on the ground(s) that a search for all the claims would not impose a serious burden. This is not found persuasive because the two groups are not obvious variants (emphasis added) and it is indeed a search burden to examine both the groups.

The requirement is still deemed proper and is therefore made FINAL.

Claim 7 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/2/07.

Applicantst are notified that the election of species with respect to cationic surfactant is hereby withdrawn.

Receipt is also acknowledged of lipid A belonging to amphipathic amide lipid belonging to formula I.

Applicantst traverse the election requirement regarding the lipid and argue that all the lipids claimed belong to Markush members, which is an acceptable manner of expressing together operable substances, which could not be defined by generic language but which nevertheless have a community of chemical and physical characteristics.

This is not found persuasive since all the lipids claimed belong to divergent molecules. The compounds are not obvious variant and art anticipating or rendering obvious one Markush member would not anticipate or render obvious other Markush members. It is a serious search burden to examine all the lipids.

Lipid is examined to the extent that it reads on formula 1(genus) and formula A (species) belonging to formula 1 shown on page 28 of the specification.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by PGPUB 20050095217 ('217).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

PGPUB '217 discloses hair cosmetic compositions using the same claimed diamide. See the abstract, see page 3, formula F for the elected diamide. See paragraph 16 for the claimed cationic surfactant. See paragraph 20 for the species belonging to cationic surfactant (claim 6). See paragraphs 21-22 and paragraphs 24-25 for claimed non-ionic and amphoteric surfactant (claim 8). See paragraph 31 for silicone derivatives (claim 4). See examples.

***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5, and 8-10 are rejected under 35 U.S.C. 103(a) as being obvious over U. S. Patent 6,685,953 ('953) or PG PUB 20030208858 ('858) or PG PUB 20030215416 ('416) or PG PUB 20030215410 ('410) or PG PUB 20050095212 ('212) or PG PUB 20040115162 ('162) all taken alone and combined with U. S. Patent 5,977,038 ('038).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

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the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

*The instant application is claiming hair cosmetic composition comprising:*

- 1. Diamide formula A*
- 2. Cationic surfactant (species is quaternium salt)*
- 3. Silicone*
- 4. Non-ionic or amphoteric surfactant*

Patent '953 teaches external preparations using the same claimed diamide. See the abstract, see col.4, formula F for the elected diamide, see col.7, lines 41-56 and see col.8, lines 8-30, where patent teaches using diamide in hair care art. Patent at col.7, line 61 teaches adding cationic surfactant along with non-ionic and amphoteric surfactant to diamide. See col.8, ll 1-29 wherein patent clearly teaches diamide in hair cosmetic.

PGPUB '858 teaches hair dye compositions using the same claimed diamide. See the abstract, see page 2, formula F for the elected diamide. PGPUB suggests at paragraph 23 adding silicones derivatives and non-ionic surfactant to diamide. See also examples for non-ionic surfactants.

PGPUB '416 teaches hair straightner compositions using the same claimed diamide. See the abstract, see page 2, formula F for the elected diamide. PGPUB suggests at paragraph 15 adding surfactants to diamide.

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PGPUB '410 teaches hair processing compositions using the same claimed diamide. See the abstract, see page 2, formula F for the elected diamide. PGPUB teaches at paragraphs 25-26 and 28 adding non-ionic and amphoteric surfactants to diamide.

PGPUB '212 teaches hair cosmetic compositions using the same claimed diamide. See the abstract, see page 3, formula F for the elected diamide. PGPUB teaches at paragraph 26 adding cationic and amphoteric surfactants to diamide. See paragraph 25 for silicones.

PGPUB '162 teaches dermatological preparations using the same claimed diamide. See the abstract, see page 3, formula F for the elected diamide. PGPUB at paragraph 26 teaches adding cationic surfactants, non-ionic and amphoteric surfactant to diamide. See paragraphs 27-31, wherein patent clearly teaches diamide in hair cosmetic.

The difference between the instant application and the commonly owned patent or PGPUB documents is they do not teach silicone with particle size. However patent '038 teaches shampoo compositions using the silicone with particle size. See col.3, ll 41 through col.4, ll 20 for silicone with particle size. Patent at col.4, ll 30-47 teaches adding cationic surfactant and non-ionic surfactants to the compositions. See also col.2, ll 15-40 for specific non-ionic and amphoteric surfactant.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the hair compositions using the diamide of patent or any PGPUB documents along with cationic, non-ionic and amphoteric surfactant and add silicones with particle size expecting beneficial effect. One of ordinary skill in the art would be motivated to add silicones since the idea of combining the ingredients flows logically from the art for having been used in the hair care compositions. One of ordinary skill in the art would be motivated to

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add silicones into the compositions with the reasonable expectation of success that the compositions with diamide, cationic and non ionic surfactant impart good touch feel to the hair and adding silicones with particle size provide conditioning effects to the hair. This is a prima facie case of obviousness.

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of EP 1,166, 766 ('766) and U. S. Patents '038 and 5,034,218 ('218).

*The instant application is claiming hair cosmetic composition comprising:*

1. *Diamide formula A*
2. *Cationic surfactant (species is quaternium salt)*
3. *Silicone*
4. *Non-ionic or amphoteric surfactant*

EP '166 teaches external preparations using the same claimed diamide. See the abstract, see page 5, formula F for the elected diamide. EP '766 at paragraph 22 teaches adding cationic surfactant along with non-ionic and amphoteric surfactant to diamide. EP at paragraphs 23-26 clearly teaches diamide in hair cosmetic. EP does not teach silicone with particle size or specific cationic surfactants. However patent '038 teaches shampoo compositions using the silicone with particle size. See col.3, ll 41 through col.4, ll 20 for silicone with particle size. Patent at col.4, ll 30-47 teaches adding cationic surfactant and non-ionic surfactants to the compositions. See also col.2, ll 15-40 for specific non-ionic and amphoteric surfactant. Patent '218 teaches stable conditioning shampoo using cationic surfactants and silicone emulsion. See the abstract; see col.5, ll 23 through col. 6 lines 53 for the cationic surfactant and specific



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cationic surfactant that are claimed in the instant application. See col.7, ll 33-52 for silicones.

See also paragraph bridging col.s 9-10 for the silicones with particle size. See the examples.


Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the hair compositions using the diamide of EP '766 and add silicones with particle size and cationic surfactant expecting beneficial effect. One of ordinary skill in the art would be motivated to add silicones and cationic surfactant since the idea of combining the ingredients flows logically from the art for having been used in the hair care compositions. One of ordinary skill in the art would be motivated to add silicones and cationic surfactant into the compositions with the reasonable expectation of success that the compositions with diamide, cationic and non ionic surfactant impart good touch feel to the hair and adding silicones with particle size and cationic surfactant provide conditioning properties such as softness to the hair. This is prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**JYOTHSNA A VENKAT Ph. D**  
**Primary Examiner**  
**Art Unit 1615**

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